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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,578	06/27/2003	Angelo Bolli	P68915US0	5779

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,578

Applicant(s)

BOLLI ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3,8 and 11-17 is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9,10,18-24 and 27 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed December 2, 2004 has been entered and fully considered.

The rejection of claim 25 under 35 USC 102(b) over Zheng et al. (US 5,985,514) is withdrawn in light of the amendment.

2. Claims 1-27 are present of which claim 27 is new.

New claim 27 is a product-by-process claim. Applicant is reminded of MPEP 2113: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4-7, 9-10, 18-24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (EP 1 129 861 A1).

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a. The image-forming material and planographic original plate taught by Nakamura meets the present respective limitations for the heat-sensitive composition and negative lithographic plate. The image-forming material contains a specific infrared absorber (abstract; [0012]), which meets the present limitations for the same. The image-forming material comprises a polymer soluble in an aqueous alkaline solution such as novolak resins ([0098]-[0104]), which meets the present limitations for the same. The material also comprises a polarity switchable substance which is converted from a lipophilic substance to a hydrophilic substance by heat ([0020]-[0025], [0125]-[0127]). The polarity switchable substance meets the present limitations for the switchable polymer. The image-forming material may also comprise a printout agent such as a triazine-based compound ([0135]) which meets the present limitations for the same.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leon et al. (US 6,190,830 B1).

a. Leon et al. teach a negative working printing plate prepared using a hydrophilic heat-sensitive imaging layer comprised of a hydrophilic heat-sensitive,

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crosslinked vinyl polymer containing a recurring organoonium groups, a photothermal conversion material. The heat-sensitive polymer reacts to provide increased oleophilicity in response to heat which is preferably generated by laser irradiation in the IR region of the electromagnetic spectrum. The imaging member is used in printing methods without the usual wet processing steps (abstract). In a preferred embodiment, a focused laser beam having an intensity of at least $0.1 \text{ mW}/\mu\text{m}^2$ is used for imaging for a time sufficient to proved a total exposure of as little as $100 \text{ mJ}/\text{cm}^2$ (column 11, lines 9-16). It would have been obvious to one of ordinary skill in the art to image the negative working printing plate of Leon et al. with a focused laser beam having an intensity of at least $0.1 \text{ mW}/\mu\text{m}^2$ and exposure of $100 \text{ mJ}/\text{cm}^2$ with reasonable expectation of improving imaging efficiency.

Allowable Subject Matter

7. Claims 2-3, 8, 11-17 are allowed.
8. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. The following is a statement of reasons for the indication of allowable subject matter:
 - a. As indicated in the Action mailed September 3, 2004, Nakamura teach an image forming material in EP 1 129 861 A1 comprising a polarity switchable image-

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forming material ([0125]), however the polarity switchable image-forming material is converted from a lipophilic substance to a hydrophilic substance, not the reverse which is required in instant claims 2-3. Additionally the material of Nakamura contains a specific infrared absorber having the specific formula represented by general formula (I). The infrared absorber is required to have at least chromophoric groups ([0021]-[0025]). There is no teaching or suggestion to modify the infrared absorber or of the specific cyanine dye required in present claim 8. The material of Nakamura may also contain a triazine-based print out agent ([0135]). However, there is no teaching or suggestion in the material of Nakamura of the specific triazine compounds required in present claims 11-17 and 26. With respect to Zheng et al. (US 5,985,514), there is no teaching or suggestion of a novolak resin or triazine compound in the hydrophilic imaging layer as required in the present claims 11-17 and 26.

b. There is no teaching or suggestion in Leon et al. (US 6,190,830 B1) of a novolak resin or triazine compound in the hydrophilic imaging layer as presently required in the claim 11-17 and 26.

Response to Arguments

10. Applicant's arguments filed December 2, 2004 have been fully considered but they are not persuasive.

11. In response to Applicant's argument that the printing plates of Nakamura et al. require development processing in an aqueous alkaline solution after exposure in contrast to the presently claimed heat sensitive composition, Applicant is reminded that

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the preamble containing this recitation has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Additionally claims 1, 4-7, 9-10, 18-26 are product claims, not method or process claims.

12. Applicant's arguments, see last paragraph bridging pages 11 and 12, filed December 2, 2004, with respect to the rejection(s) of claim(s) 25 under 35 USC 102(b) over Zheng et al. (US 5,985,514) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the amendment to claim 25 and See paragraph above.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In US 6,610,458 B2, Miller et al. teach a method and system for direct-to-press imaging wherein the imageable coating taught therein comprises a thermally switchable polymer.

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14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
February 11, 2005